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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,431	06/29/2001	Richard Qian	42390P11146	8957

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/895,431

Applicant(s)

QIAN, RICHARD

Examiner

Susan Y Chen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2171

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/12/2004 has been entered.

This office action is in response to amendment filed on 04/12/2004.

Claims 31-59 are newly added and pending for examination, claims 1-30 have been canceled.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31-34 and 36-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Sezan et al. (U.S. Patent No. 6,236,<sup>12</sup>395).

As to claim 31, Sezan et al. (hereinafter referred as Sezan) discloses a device [e.g., television sets, a home stereo and home entertainment center, cable TV, satellite TV, a computer, a PDA, a cellular phone, a portable media player, a web terminal, and a set-top box ; col. 2, lines 66 – col. 3, line 5; col. 6, lines 5-6; lines 23-30] comprising:

- a) a portable medium [e.g., the user description scheme, col. 6, lines 3-9];
- b) a machine-readable medium of the portable medium [e.g. the smart card, col. 6, lines 3-9];
- c) Instructions stored on the machine-readable medium having user preference information [e.g., the user description schema having user preference information which is stored in handheld electronic device or smart card or a network connected multiple devices, col. 6, lines 3-9];
- d) Instructions stored on the machine-readable medium to provide a template database [e.g., the data storage unit 950), Fig. 2], the template database including a plurality of user preference templates for identifying a user, wherein the user inserting a smart card issued by an issuer into a plurality of devices to customize each of the corresponding device [e.g., col. 10, lines 38-46], therefore, allowing the portable medium to be compatible with a plurality of different devices [e.g., Fig(s). 2-3 and

associated texts; col. 5, lines 37 – col. 6, line 20, col. 9, lines 1-25; col. 9, line 34 – col. 10, line 56].

As to claims 32-33, except all the features discussed in claim 31, Sezan further discloses that the template database provides user identification information and user history information templates [e.g., col. 21, lines 30 – 36; the overall structure of the User Description Scheme at col. 21 – col. 24].

As to claim 34, except all the features discussed in claim 31, Sezan further discloses that the portable medium comprises a smart card [e.g., col. 6, lines 3-7].

As to claim 36, Sezan discloses a system [e.g., Fig. 1 and associated texts] having all the features as claimed by applicant, comprising:

a) a device including a communication device to provide a communication link to a network [e.g., Fig. 2 and associated texts, col. 7, lines 55 – col. 9, line 33];

b) a portable medium including a machine-readable medium to store user preference information [e.g., col. 5, lines 37-40, col. 6, lines 3-9];

c) Instructions stored on the machine-readable medium to store user preference information [e.g., the user description scheme having user preference information which is stored in handheld electronic device or smart card or a network connected multiple devices, col. 6, lines 3-9];

d) Instructions stored on the machine-readable medium to provide a template database, the template database including a plurality of user preference templates, each corresponding to a particular device, to allow the portable medium to be compatible with a plurality of different devices [e.g., Fig(s). 2-3 and associated texts; col. 5, lines 37 – col. 6, line 20, col. 9, lines 1-25; col. 9, line 34 – col. 10, line 56].

As to claim 37, except all the features recited in claim 36, Sezan further discloses the device is selected from a computer and a television [e.g., col. 9, lines 34 – col. 10, line 4; col. 11, lines 26-31].

As to claim 38, except all the features recited in claim 36, Sezan further discloses the portable medium comprises a smart card and the card is inserted into a slot of the device [e.g., col. 6, lines 3-7; col. 11, lines 23-25].

As to claim 39, the claimed features – the communication device is selected from a modem and a network interface card is read by the default network / Internet communication channel processing [e.g., col. 7, line 59, col. 8, line 3].

As to claims 40-44 and 48-59, the steps in the claimed method are deemed to be made inherent by the functions of the apparatus structure in the combination discussed above, hence were rejected for the same reasons.

As to claims 45-47, these claims recite the same features of claims 31-34, 36-44 and 48-59 in form of a machine-readable medium having computer program to be executed by a processor, hence they are rejected for the reason.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezan et al. (U.S. Patent No. 6,236,295) <sup>IL</sup> in view of Feyt et al. (U.S. Patent No. 6,698,662).

As to claims 35, Sezan discloses all the claimed features as recited in claim 34, except he did not specifically teach the smart card comprises a microprocessor.

However, Feyt et al. (hereinafter referred as Feyt) discloses a smart card comprises a microprocessor [e.g., Abstract, col. 4, claim 2, lines 13-23].

Therefore, with the teachings of Sezan and Feyt in front of him/her, an ordinary skilled artisan at the time the invention was made would have been obviously motivated

to further modify a smart card to comprise a microprocessor, because by doing so, the microprocessor cards will hiding the operations performed whilst permitting the programmer the free choice of the programming rules, where or not they are of the "byte oriented" type. [Feyt: col. 1, lines 53-57].

### ***Response to Arguments***

Applicant's arguments with respect to newly amended claims 31-59 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2171

May 5, 2004

  
**UYEN LE**  
**PRIMARY EXAMINER**